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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,283	12/08/2004	Patrice Bujard	SE/2-22853/A/PCT	5717

324 7590 09/12/2006

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TARRYTOWN, NY 10591-9005

EXAMINER
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HAILEY, PATRICIA L

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 09/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/517,283

Applicant(s)

BUJARD ET AL.

Examiner

Patricia L. Hailey

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12 is/are allowed.
- 6) ☐ Claim(s) 1-6,9-11 and 13-18 is/are rejected.
- 7) ☒ Claim(s) 7 and 8 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                        |                                                                   |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>03/09/05</u> .                                                | 6) <input type="checkbox"/> Other: _____                          |

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Applicants' Preliminary Amendment, filed on December 8, 2004, has been made of record and entered. In this amendment, claims 1-11 have been amended to conform to proper U. S. Patent format, and new claims 13-18 have been added.

Claims 1-18 are now pending in this application.

### ***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Applicants' Priority Documents were filed on December 8, 2004.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. ***Claims 1-6, 9-11. and 13-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Weinert et al. (U. S. Patent Application Publication No. 2005/0161678).***

*The applied reference has common inventors with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under*

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*35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.*

Weinert et al. disclose plane-parallel structures of  $\text{SiO}_y$ , wherein  $1 \leq y \leq 1.8$ , and wherein  $y$  can equal 0.95. See paragraph 62 of Weinert et al. (considered to read upon **claims 1, 13, and 14**).

Weinert et al. also disclose  $\text{SiO}_2$  flakes having "a high plane-parallelism" having a thickness. Said flakes also can be provided with one or more metal oxide and/or metal layers, wherein, in case of the metal oxide, a metal oxide layer having a high index of refraction is deposited first. Further, it is possible to obtain pigments on the basis of  $\text{SiO}_2$  substrates (considered to read upon **claims 2, 3, 15, and 16**) comprising metal oxides such as those recited in Applicants' **claims 4, 5 and 18**, defined in Weinert et al. as a "dielectric material having a 'high' refractive index". See paragraph 126 of Weinert et al., as well as paragraph 75, which depict exemplary pigments that read upon **claim 6**.

The pigments disclosed in Weinert et al. can be employed in pigmenting "high molecular weight organic material". See paragraph 147 of Weinert et al., as well as paragraph 152, which discloses percentage amounts of the high molecular weight organic material corresponding to Applicants' **claims 9 and 17**.

Paragraphs 157-159 of Weinert et al. disclose that, for pigmenting surface coatings and printing inks, the high molecular weight organic materials, the pigments

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disclosed in Weinert et al., and customary additives are finely dispersed or dissolved in an organic solvent or solvent mixture, to obtain colorations. This disclosure is considered to read upon Applicants' **claim 11**.

Paragraph 162 of Weinert et al. disclose a cosmetic preparation or formulation comparable to that recited in Applicants' **claim 10**.

In view of these teachings, Weinert et al. anticipate claims 1-6, 9-11. and 13-18.

***Allowable Subject Matter***

4. Claims 7 and 8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

5. Claim 12 is allowed.

6. The following is a statement of reasons for the indication of allowable subject matter:

Weinert et al. do not teach or suggest pigments as recited in Applicants' claims 7 and 8. With respect to claim 12, paragraphs 20-27 of Weinert et al. disclose a method comparable to that recited in claim 12. However, the reference discloses oxidizing the structures in an oxygen-containing gas at temperatures greater than 200°C; see, for example, paragraph 61 of Weinert et al.

***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

8. Bujard et al. (U. S. Patent Application Publication No. 2006/0042507, and WO 2004/035693) disclose pigments strongly similar to that instantly claimed; however, both documents are disqualified as prior art under 35 U.S.C. 102, as the 371(c) date of the Publication and the International Publication Date of the WO document are subsequent to Applicants' effective filing date of June 16, 2003.

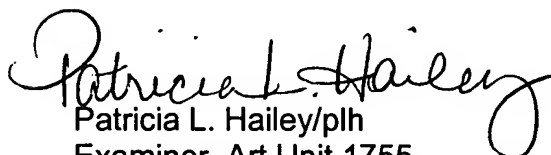
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Hailey whose telephone number is (571) 272-1369. The examiner can normally be reached on Mondays-Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo, can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group 1700 Receptionist, whose telephone number is (571) 272-1700.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Patricia L. Hailey/plh  
Examiner, Art Unit 1755  
September 11, 2006



J.A. LORENZO  
SUPERVISORY PATENT EXAMINER